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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,793	07/16/2003	Chris Felcman	200302235-2	1457

7590 11/03/2004

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EXAMINER

NOVOSAD, JENNIFER ELEANORE

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,793

Applicant(s)

FELCMAN ET AL.

Examiner

Jennifer E. Novosad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2004 and 16 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>10-18-2004</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

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DETAILED ACTION

This non-final Office action is in response to the election filed August 16, 2004 and the response filed May 17, 2004 (including declarations filed under 35 C.F.R. § 1.131 and 1.132).

Election/Restriction

Applicant's election with traverse of claims 1-22, 41-46, 51-53, and 56-57 in the reply filed on August 16, 2004 is acknowledged. The traversal is on the ground "of a lack of 'serious burden' on the Examiner". While the examiner still contends that the groupings are patentably distinct from one another, applicant's argument concerning "serious burden" is found to be persuasive since applicant has not amended the claims in any way so as to change the scope of the claim, therefore requiring a further search, which can be considered to be a showing of serious burden. *Accordingly*, the restriction requirement is withdrawn and all claims have been examined on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 51, 8, 9, 13, 14; 15-18; 33-36, 38, 40; 41-44; and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,594,617(Foster *et al.* '617).

Foster *et al.* '617 teach a computer having a housing approximately one inch thick (see column 7, line 16), i.e., less than 1/2U and inherently capable of being mounted in a 1U thick rack space, i.e., since the computer is less than 1U thick it would fit in a space that is 1U thick, comprising a flat display panel rotatably attached, by a hinge, to an input device, i.e., keyboard having a trackball (see column 7, line 3) whereby the display panel is less than 1/2U, i.e., 7.5mm, and the input device is less than 3/4 U thick. The way in which the display lies adjacent the keyboard and is pivoted at a hinge thereon, the computer of Foster *et al.* '617 is considered to define a clamshell configuration. With respect to the recitation "mountable" (in line 3 of claim 1, line 3 of claim 15, line 5 of claim 41, and line 4 of claim 56), it is noted that the structure of Foster *et al.* '617 is capable of forming such an assembly, i.e., the claim is only positively requiring an assembly and not a rack. *For example*, if a book shelf unit were called a rack and then the structure of Foster *et al.* '617 were placed on one of those shelves, the structure would then be a "rack mountable assembly". It is noted that the claims do not define, in any way, what defines the rack even though it is functionally recited. *Thus*, the afore-mentioned example is considered to be a broad interpretation of the "rack mountable assembly" recitation.

With respect to claims 33-36, 38, and 40, Foster *et al.* '617 show the structure capable of performing the method steps of: providing a computer having a housing approximately one inch thick (see column 7, line 16), i.e., less than 1/2U in a closed configuration and inherently capable of being mounted in a 1U thick rack space bounded by the area in which the computer is disposed, comprising a flat display panel rotatably attached, by a hinge, to an input device, i.e., keyboard having a trackball (see column 7, line 3) or pointing device whereby the display panel is less than 1/2U, i.e., 7.5mm, and the input device, i.e., the keyboard, is less than 3/4 U thick.

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With respect to the recitation "in a rack mount computer system" in claim 33, it is noted that the claim is not positively requiring a rack mount computer system, and as advanced above, a bookshelf, for example, can define such an arrangement, as required by the language of the claim. *Further*, as advanced above, since the thickness of the computer is less than 1U, the space to which the computer is disposed would define the space specified for in the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-12 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster *et al.* '617, alone.

Foster *et al.* '617 disclose the computer as advanced above.

The claims differ from Foster *et al.* '617 in requiring the assembly to be approximately 17.5 inches wide and 19.25 inches deep.

Although Foster *et al.* '617 is silent as to the width and depth of the computer, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have had a computer having the specified dimensions, for increased storage capabilities.

Claims 7; 22, 53; 39; 45; 52; and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster *et al.* '617 as applied to claims 1-6, 51, 8, 9, 13, 14; 15-18; 33-36, 38,

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40; 41-44; and 56 above, and further in view of U.S. Design Patent No. Des. 374,662 (Soderburg '662).

Foster *et al.* '617 disclose the computer as advanced above.

The claims differ from Foster *et al.* '617 in requiring the panel display to be nested within the input device.

Soderburg '662 teaches a computer whereby the display is nested, i.e., at the upwardly curved rear section and downwardly curved front section (it is noted that the claims do not specifically define at which points the elements are nested, e.g., sides and the back), within the keyboard in a clamshell configuration whereby the computer is opened and closed when needed. It is noted that the claims are only positively claiming the interaction assembly and not the rack, nor the rack space (defined in line 4 of claim 56) and thus the computer of Soderburg '662 is considered to be capable of being "mountable", as called for in line 4 of claim 56.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a computer having a nesting capability for increased safety and securement of the display panel.

Claims 23-26, 54; 28-32; 47, 48, 50; and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster *et al.* '617 in view of U.S. Patent No. 6,142,590 (Harwell '590).

Foster *et al.* '617 disclose the computer as advanced above.

The claims differ from Foster *et al.* '617 in requiring: (a) a rack structure having a plurality of rack spaced and the computer having a height of 1U to be disposed in the space; (b) slidably removing the computer from a 1U thick rack space; and (c) the assembly to be approximately 17.5 inches wide and 19.25 inches deep.

It is noted that claim 23 is not requiring the height of the space to be 1U, but rather the height of the computer is 1U and is disposed in a space, having no specific height. *Thus*, as advanced below, Harwell teaches the use a rack having rack spaces, which need not be 1U, since the claims are not requiring this feature.

With respect to (a), Harwell '590 teaches rack mount computing system comprising a user interaction assembly mountable in a rack space defined in the system whereby the rack space is 2U thick, i.e., the space is capable of holding a 1U or less computer assembly therein, and the user interaction assembly comprises an input device, i.e., a keyboard having scroll buttons and computing circuitry, that is rotatably disposed adjacent a display panel (20); the user interaction assembly further comprises a component housing (32) defining a video controller for the circuitry. Harwell '590 is considered to teach the method steps of disposing a keyboard in a rack space in a server rack, providing a graphical coordination device adjacent the keyboard, slidably removing the keyboard from a space in the rack and rotatably opening the display. *With respect to claim 40*, Harwell '590 is considered to show structure capable of performing the method steps of providing an open configuration for operation of the keyboard with the display being partially withdrawn from the space. It is noted that the claims are not positively claiming a 1U thick rack space.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the computer of Foster *et al.* '617 into the system of Harwell '590, since the computer of Foster *et al.* '617 is of a size that is able to be stored in and used with the system of Harwell, thereby allowing for ease in use to the consumer, since more computers can be stored in less space.

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With respect to (b), it would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the computer of Foster *et al.* '617 in the system of Harwell '590 in a sliding manner for ease in use to the consumer.

With respect to (c), although Foster *et al.* '617 is silent as to the width and depth of the computer, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have had a computer having the specified dimensions, for increased storage capabilities.

Claims 27, 49, 55, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster *et al.* '617 in view of Harwell '590 as applied to claims 23-26, 54; 28-32; and 58 above, and further in view of Soderburg '662.

The claims differ from Foster *et al.* '617 in requiring the panel display to be nested within the input device.

Soderburg '662 teaches the computer as advanced above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a computer having a nesting capability for increased safety and securement of the display panel.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foster *et al.* '617 as applied to claims 1-6, 51, 8, 9, 13, 14; 33-36, 38, 40; 41-44; and 56 above, and further in view of U.S. Patent No. 6,142,590 (Harwell '590).

Foster *et al.* '617 disclose the computer as advanced above.

The claim differs from Foster *et al.* '617 in requiring the computer to be disposed in a server rack.

Harwell '590 teaches the system as advanced above.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the computer of Foster *et al.* '617 into the system of Harwell '590, for ease in organizational capabilities and capacity.

Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foster *et al.* '617 in view of Soderburg '662 as applied to claims 7; 22, 53; 39; 45; 52; and 57 above, and further in view of Harwell '590.

The claim differs from the above references in requiring coupling a linear positioning structure to the assembly to facilitate slidable mounting into a rack structure. It is noted that the claim is not positively requiring the mounting or the rack structure.

Harwell '590 teaches the system as advanced above.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have placed the computer of Foster *et al.* '617 in the system of Harwell '590 in a sliding manner for ease in use to the consumer.

Response to Amendment

The declarations filed on May 17, 2004 under 37 CFR 1.131 are sufficient to overcome the Sikat *et al.* '453 reference.

The declarations under 37 CFR 1.132 filed May 17, 2004 have been considered and are sufficient to overcome the rejection of claims, i.e., 23-32, 54, 55, 58, and 59, based upon the *combination* of Harwell '590 in view of Foster *et al.* '617 and Baddour *et al.* '033. *However*, it is noted that in view of the new grounds of rejection, the declarations, arguments, and/or

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discussions concerning the combination of these references is rendered moot in view of the new grounds of rejection.

Response to Arguments

Applicant's arguments with respect to claims 1-39 and 45-59 have been considered but are moot in view of the new ground(s) of rejection. It is noted that while the Harwell and Foster *et al.* references were used in combination in the previous Office action, the way in which the references are combined in this Office action is different. *Thus*, applicant's arguments with respect to the combination of these references is considered to be moot.

With respect to claims 41-44 and the foster *et al.* reference, applicant's arguments (bridging pages 14 and 15) have been considered.

Firstly, regarding claim 41 and the Foster *et al.* reference, it is noted Foster *et al.* disclose an assembly, i.e., a portable computer, that is 1 inch thick, i.e., less than 1U thick and hence these limitations of the claim are clearly met. *Further*, it is noted that claim 41 does not recite that the assembly is "mounted", i.e., positively, in any manner to any structure; that is, the claim is only reciting the structure of the "assembly". The fact that applicants have chosen to refer to the "assembly" as "rack mountable" is irrelevant since there is no structure in the claim that is not in the reference, i.e., the reference need only *be capable* of being "rack mountable" in order to meet the language of the claim. *Accordingly*, Foster *et al.* are still considered by the examiner to meet the limitations of the claims.

Secondly, applicant's arguments (at the bottom of page 14) that "a functional limitation must be given patentable weight in the context in which it is used" are acknowledged. However,

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as noted above, if a reference is *capable* of functioning in the same way as in as in the claim, i.e., in this case being *capable* of being "rack mountable", then the reference meets the language of the claim. The reference need not positively show or disclose what the claim of the instant invention is requiring in order to meet the claim.

Finally, with respect to applicant's arguments (in the middle of page 15) that "Microsoft Computer Dictionary defined rack mounted as: 'built for installation in a metal frame or cabinet of standard width and mounting arrangement'", this argument is considered to be more limiting than what is actually being and is therefore not commensurate with the scope of the claims. In particular, the claims recite "rack mountable", i.e., this recitation is functional, while this argument states "rack mounted", i.e., positively claiming that that the elements are mounted to a structure. *Finally*, it is the examiner's position that since the Foster *et al.* reference disclose the thickness as less than 1U, that the area of space occupied by the thickness of the device, would be "mountable" in that space.

Next, regarding the Foster *et al.* and applicant's arguments (on page 21), it is noted that the mere fact that the assembly of Foster *et al.* is "portable" is considered to be more limiting than what is actually being claimed and therefore is not commensurate with the scope of the claims. *In particular*, the claims recite the limitation "mountable" which is functional and do not in any way positively link the claimed structure to "rack space". *Further*, the claims do not require that the assembly be adapted to be "permanently" mountable or "immovably" mountable. In fact, the specification of the instant application (see page 6, lines 10-15) recites that the devices may be "fixedly or movably coupled to the rack". In view of the claims and specification, since a rack is not being positively claimed in claims 41 and 56, the "portability" of

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Foster *et al.* is considered to not be commensurate with the scope of the claims. Again, note that the space is not being positively claimed in claims 1, 15, 33 and 47.

It is noted that applicant's arguments, such as "the Examiner's argument... is 'merely functional', is an insufficient reason to dismiss the limitation" (see the last sentence of the first partial paragraph on page 22), are acknowledged. *However*, these limitations, to which applicant refers, have not been "dismissed" but rather have been given no patentable weight. The Examiner has advanced discussion of certain functional limitations (as seen above) to clarify the applied references with respect to the rejected claims. This clearly shows that the examiner has not "dismissed" these limitations.

In response to applicant's argument that there is no suggestion to combine the references (see the first paragraph on page 23), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Firstly, it is unclear to which claims applicant is referring. The Harwell and Foster *et al.* references have been combined differently, and in each instance, different teachings have been discussed. *Nonetheless*, the fact the Foster *et al.* reference is portable does not inhibit it from being "mountable" in a rack.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning (see the second full paragraph on page 23), it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based

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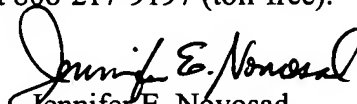
upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Novosad whose telephone number is (703)-305-2872. The examiner can normally be reached on Monday-Thursday, 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on (703)-308-0839. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer E. Novosad
Examiner
Art Unit 3634

Jennifer E. Novosad/jen
October 28, 2004